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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YU-HUNG KAO¹

Appeal 2007-2941
Application 09/583,432
Technology Center 2600

Decided: December 28, 2007

Before JAMESON LEE, RICHARD TORCZON, and SALLY C.
MEDLEY, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

1 DECISION ON APPEAL

2 A. Statement of the Case

3 This is a decision on appeal by an Applicant under 35 U.S.C. § 134(a)
4 from a final rejection of claims 31-35. We have jurisdiction under 35 U.S.C.
5 § 6(b).

¹ The real party in interest is Intel Corporation.

<u>References Relied on by the Examiner</u>		
3	Miyagawa	US 4,989,081
4	Klosterman	US 5,923,362
5	Mahvi	US 6,259,486
6	Brusky	US 6,285,426

The Rejections on Appeal

10 The Examiner rejected claims 31-34 under 35 U.S.C. § 102(e) as
11 anticipated by Brusky.

12 The Examiner rejected claims 31-34 under 35 U.S.C. § 102(b) as
13 anticipated by Miyagawa.

14 The Examiner rejected claims 31 and 32 under 35 U.S.C. § 102(e) as
15 anticipated by Klosterman.

16 The Examiner rejected claim 35 under 35 U.S.C. § 103 (a) as
17 unpatentable over Brusky and Mahvi.

18 The Examiner rejected claim 35 under 35 U.S.C. § 103 (a) as
19 unpatentable over Miyagawa and Mahvi.

20
21 B. Issues
22

23 The Applicant states the issues in this appeal as follows (Br. 7:14-17):
24 (1) Is claim 31 anticipated by Brusky? (2) Is claim 31 anticipated by
25 Miyagawa? and (3) Is claim 31 anticipated by Klosterman? As in any
26 appeal, it is the Applicant as appellant who must demonstrate error in the
27 underlying rejection. More correctly stated, the issues are: (1) Whether
28 Applicant has shown error in the anticipation rejection of claim 31 over
29 Brusky; (2) Whether Applicant has shown error in the anticipation rejection

1 of claim 31 over Miyagawa; and (3) Whether Applicant has shown error in
2 the anticipation rejection of claim 31 over Klosterman?

3 Technically, the Applicant has not appealed the obviousness rejection
4 under 35 U.S.C. § 103 of claim 35 over Brusky and Mahvi, or the
5 obviousness rejection under 35 U.S.C. § 103 of claim 35 over Miyagawa and
6 Mahvi, because the only issues set forth by the Applicant are the anticipation
7 rejections of claim 31 under 35 U.S.C. 102. Similarly, the Applicant
8 technically also has not appealed the anticipation rejection of claims 32, 33,
9 and 34. However, on page seven of Applicant's brief, it is stated that claims
10 32-35 may be grouped with claim 31. It appears that the Applicant regards
11 all rejections by the Examiner, both for anticipation and for obviousness,
12 whether applied to claims 32-34 and 35 or merely claim 31, as being at issue
13 in this appeal. We give Applicant the benefit of the doubt and consider all
14 rejections by the Examiner as having been appealed.

15
16 C. Summary of the Decision

17 The Applicant has not shown error in the anticipation rejection of
18 claims 31-34 over Brusky.

19 The Applicant also has not shown error in the obviousness rejection of
20 claim 35 over Brusky and Mahvi, or in the obviousness rejection of claim 35
21 over Miyagawa and Mahvi.

22 The Applicant has shown error in the anticipation rejection of claims
23 31-34 over Miyagawa.

24 We do not reach the anticipation rejection of claims 31 and 32 over
25 Klosterman.

26

1 D Findings of Fact (Referenced as FF. ¶ No.)

2 1. The Applicant's disclosed invention relates to a method to
3 make a processor-based appliance act more like a conventional appliance by
4 reducing the time it takes for the processor-based appliance to be ready to
5 operate from the moment it is activated by a user. (Spec. 1-2).

6 2. The specification describes a set-top box embodiment in which
7 operation of a power button, either on the unit or on a remote control, does
8 not initially apply power to the device but instead transitions the device from
9 a standby state to the on state; power is always applied even in the standby
10 state. (Spec. 6:5-14).

11 3. As described, the disclosed set-top box has a "stand by" state in
12 which the device maintains all of its settings and is able to operate quickly in
13 response to user command. (Spec. 4:19-21). In the "standby" state, the
14 device consumes less power than in an "on" state. (Spec. 4:21-23).

15 4. Also described is an optional "sleep" state. If the device stays
16 in "standby" state for too long, it may transition to the sleep state, but if
17 activity is detected, the device would return to the "standby" state. (Spec.
18 6:22 to 7:3). In the sleep state, the set-top box may be in an even lower
19 power consumption state but may be unable to return immediately to being
20 fully operational. (Spec. 7:4-8).

21 5. In the specification, it is stated (Spec. 7:8-13):

22 [A] time delay may be required to transition from the sleep state
23 32 to the standby state 34 and then on to the on state 36. The
24 transition from the sleep state 32 to the on state 36 may take
25 more time than the transition from the standby state 34 to the on
26 state 36 in one embodiment.

1 6. The specification discloses use of a light sensor to detect light
2 produced by a television receiver, for causing the set-top box to transition
3 from the sleep state 32 to the standby state 34. (Spec. 7:26 to 8:3).

4 7. Claims 31-35 are reproduced below:

5 31. A method comprising:

6
7 enabling a processor-based system to transition from a
8 lower power consumption state to a higher power consumption
9 state in response to operation of a television receiver.

10
11 32. The method of claim 31 including transitioning the
12 processor-based system between different power consumption
13 states in response to operation of a power button.

14
15 33. The method of claim 32 including transitioning
16 said system between power consumption states in response to
17 the amount of activity on the processor-based system.

18
19 34. The method of claim 33 including transitioning
20 said processor-based system based on activity surrounding said
21 processor-based system.

22
23 35. The method of claim 34 including detecting
24 motion around said processor-based system.

25 E. Principles of Law

26 In proceedings before the USPTO, claim terms are construed
27 according to their broadest reasonable interpretation consistent with the
28 specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1990); *In re Prater*,
29 415 F.2d 1393, 1404 (CCPA 1969). It is well established that limitations
30 from the specification, not otherwise required by the claims, shall not be
31 read into the claims. *In re Priest*, 582 F.2d 33, 37 (CCPA 1978); *In re*
32 *Prater*, 415 F.2d at 1404 (CCPA 1969).

1 To establish anticipation under 35 U.S.C. § 102, each and every
2 element in a claim, arranged as is recited in the claim, must be found in a
3 single prior art reference. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242
4 F.3d 1376, 1383 (Fed. Cir. 2001). Anticipation can be found when a claim
5 limitation is inherent or otherwise implicit in the relevant reference.
6 *Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360,
7 1369 (Fed. Cir. 1991). For establishing inherency, that which is missing in
8 the express description must necessarily be present and would be so
9 recognized by one with ordinary skill in the art. *Continental Can Co. v.*
10 *Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Inherency may not be
11 established by probabilities or possibilities, and the mere fact that a certain
12 thing may result from a given set of circumstance is not sufficient. *In re*
13 *Oelrich*, 666 F.2d 578, 581 (CCPA 1981).

14 F. Analysis

15 We summarily affirm the obviousness rejection of claim 35 over
16 Brusky and Mahvi, and also the obviousness rejection of claim 35 over
17 Miyagawa and Mahvi, under 35 U.S.C. § 103. The Applicant has provided
18 no argument directed specifically toward the obviousness rejections. Even
19 assuming that the rejections of claim 31 for anticipation over Brusky and
20 over Miyagawa were improper, that does not demonstrate error in the
21 rejection of claim 35 for obviousness over Brusky and Mahvi, or over
22 Miyagawa and Mahvi. The Applicant simply has not discussed or analyzed
23 nonobviousness. No error has been shown in that regard.

The Anticipation Rejection over Brusky

2 With respect to claim 31, the Applicant argues (Br. 8:15-20):

The claim calls for the processor-based system to transition power consumption states “in response to operation of a television receiver.” In Brusky, the PC part of the PC/TV does not power up in response to operation of a television receiver. It responds only to the on/off button, which separately supplies power to both the PC and the TV. As a result, it cannot be said, in Brusky, that the power consumption state change is “in response to operation of a television receiver.”

The argument is misplaced because the Applicant reads the claim language “in response to operation of a television receiver” much more narrowly than is appropriate during patent examination. In proceedings before the USPTO, claim terms are construed according to their broadest reasonable interpretation consistent with the specification. *In re Zletz*, 893 F.2d at 321; *In re Prater*, 415 F.2d at 1404. It is apparent that Applicant would like to limit the meaning of “in response to operation of a television receiver” to a response to some steady state operation, such as the level of illumination surrounding and coming from the television display, but not a transitional operation of the television such as powering on the television. There is no reason why the initial act of turning on the television should be excluded from the scope of “operation of a television receiver.” It is amply reasonable to characterize powering on a television receiver as operating the television receiver. And that is not diminished by having the same power on for the television and the processor-based unit.

The scope of claim 31 is rather broad. If by turning on the television computer is turned on as well, as it is the case in Brusky, it is reasonable regard the turning on of the computer as being in response to operation of

1 the television. Although the Applicant discloses a specific embodiment
2 using a sensor to detect light emitted from the television monitor when the
3 television is turned on (Spec. 7:21 to 8:5), it is well established that
4 limitations from the specification, not otherwise required by the claims, shall
5 not be read into the claims. *In re Priest*, 582 F.2d 33, 37 (CCPA 1978); *In*
6 *re Prater*, 415 F.2d 1393, 1404 (CCPA 1969). It is the claim which defines
7 the scope of the invention sought to be patented, not the specification.

8 Our interpretation is also not inconsistent with the Applicant's own
9 disclosure. Note original claim 6 which recites that the transition of the
10 processor-based system from a lower power consumption state to a higher
11 power consumption state occurs "whenever the television receiver is
12 operating." That description makes it all the more reasonable to regard
13 Brusky's computer which is powered on by the same switch that powers on
14 Brusky's television as a device transitioning to a higher power consumption
15 state, from "off" to "on," as being in response to operation of the television
16 receiver. The turning on of the television constitutes operation of the
17 television, and the resulting transition of the computer from a low power
18 consumption "off" state to a high power consumption "on" state is
19 reasonably deemed a response to operation of the television receiver.

20 In the Reply Brief, the Applicant notes that in Brusky's system if the
21 television receiver is broken in that it will not respond to the remote control,
22 then the claimed feature would not be met. That is true. But that fact does
23 not undermine the anticipation rejection, because when all of Brusky's
24 disclosed components are operating correctly and not assumed to be broken,
25 each of the claimed features of claim 31 is met. The Examiner is correct in
26 not assuming that any component of the prior art would be broken.

1 For the foregoing reasons, Applicant has not shown error in the
2 anticipation rejection of claim 31 over Brusky. Because the Applicant has
3 grouped claims 32-34 with claim 31, Applicant also has not shown error in
4 the anticipation rejection of claims 32-34 over Brusky.

5 The Anticipation Rejection over Miyagawa

6 Claim 31 requires enabling a processor-based system to transition
7 from a lower to a higher power consumption state in response to operation of
8 a television receiver. According to the Examiner, the video tape recorder
9 (VTR) in Miyagawa constitutes such a processor-based system. The
10 Applicant disputes and challenges the Examiner's assertion that Miyagawa's
11 VTR is a processor-based device. The Examiner cites to nothing in
12 Miyagawa which identifies the VTR as a processor-based device, and the
13 Examiner cites to no supporting evidence that a VTR at the time of filing of
14 Miyagawa was known to always be a processor-based device. Specifically,
15 the Examiner states (Ans. 4:19 to 5:2):

16 VTR is well-known to utilize multi-microprocessor system to
17 operate as a main CPU to control internal bus. VTR of
18 Miyagawa clearly shows a "bus line" (28).

19
20 An assertion of technical fact must be supported by citation to some
21 evidence, at least when the asserted fact is challenged by the applicant for
22 patent, as it is here. *See, e.g., In re Ahlert*, 424 F.2d 1088, 1091 (CCPA
23 1970). The Examiner's assertion is mere conclusory and also does not
24 appear to focus on the time period of the Miyagawa reference. On this
25 record, the Examiner has failed to show that at the time of filing of
26 Miyagawa as a patent application, a "VTR" or "video tape recorder" was

1 known in the art to always be a processor-based device or that the presence
2 of a “bus line” is not compatible with anything but a processor-based device.

3 For the foregoing reasons, the anticipation rejection of claim 31 over
4 Miyagawa cannot be sustained. Because claims 32-34 depend directly or
5 indirectly from claim 31, the anticipation rejection of claims 32-34 over
6 Miyagawa also cannot be sustained.

7 **The Anticipation Rejection over Klosterman**

8 We do not reach the anticipation rejection of claims 31 and 32 over
9 Klosterman.

10 **G. Conclusion**

11 The rejection of claims 31-34 under 35 U.S.C. § 102(e) as anticipated
12 by Brusky is affirmed.

13 The rejection of claims 31-34 under 35 U.S.C. § 102(b) as anticipated
14 by Miyagawa is reversed.

15 The rejection of claim 35 under 35 U.S.C. § 103(a) as unpatentable
16 over Brusky and Mahvi is affirmed.

17 The rejection of claim 35 under 35 U.S.C. § 103(a) as unpatentable
18 over Miyagawa and Mahvi is affirmed.

19 We do not reach the rejection of claims 31 and 32 under 35 U.S.C.
20 § 102(e) as anticipated by Klosterman.

21 No time period for taking any subsequent action in connection with
22 this appeal may be extended under 37 C.F.R. § 1.136(a).

23

AFFIRMED

Appeal 2007-2941
Application 09/583,432

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